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09/764,021	01/16/2001	Steven Lurie	04704.P012	8048

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EXAMINER
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CHOW, MING

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/764,021

**Applicant(s)**

LURIE, STEVEN

**Examiner**

Ming Chow

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-100 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-100 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

***Response to Amendment***

1. The amendments to the specification filed on 6-28-04 is objected to as the amendments are referenced by section numbers. The original specification was provided with line numbers and page numbers and the Examiner cannot relate the sections numbers to the appropriate line numbers and page numbers.

2. The reply filed on 6-28-04 is not fully responsive to the prior office action because the Applicant failed to respond to rejections under 35 U.S.C. 112, second paragraph to claims 58, 63 although Applicant states amendments have been provided.

Also, Applicant failed to respond to the drawing objections regarding missing legends.

However, in order to speed up the examination process, the Examiner waives the rule for this Office Action. The Applicant, in the future, must respond to all addressed objections and rejections when replying to the prior Office Action.

***Claim Objections***

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3. Claims 1, 17, 97 recite "the user" (line 10). There is insufficient antecedent basis for this limitation in the claim.

### ***Drawings***

4. The drawings are objected to because proper legend for item 160 Fig. 1 and Fig. 2 was missing. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 10, 29, 48, 68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "the rate" (line 2) is not clearly defined. It is unclear the claimed "the rate" refers to "a rate" (line 1 of claim 10) or "the rate" (line 2 of claim 9).

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6. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "the connection" (line 2) is not clearly defined. It is unclear the claimed "the connection" refers to "an internet connection" (line 6-7 of claim 17) or "a real-time communications connection" (line 11 of claim 17).

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 57 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase "giving the selected service provider an option to access a database of alternate service providers when the selected provider cannot be reached" is not disclosed by the

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specification. On line 1-13, the specification discloses that when the selected service provider cannot be reached the user is provided an option to select an alternate provider. The specification did not disclose when the selected service provider cannot be reached the selected service provider is given an option to access a database for an alternate.

8. Claims 58, 63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "the service provider" is not clearly defined. It is unclear the claimed "the service provider" refers to "selected service provider" or "alternate service provider" or both claimed in claim 57.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 1, 2, 4, 7, 19, 24, 27, 37, 38, 39, 40, 42, 44, 57, 58, 61, 63, 64, 77-80, 82, 84, 97, 98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singh (US: 6389278), and in view of Faber et al (US: 2002/0010608).

For claims 1, 2, 4, 7, 19, 24, 27, 37-40, 42, 44, 57, 58, 61, 63, 64, 77-80, 82, 84, 98, Singh teaches on column 2 line 19-29 a list of service providers is provided for the initial call. Singh teaches on column 4 line 12-16, service providers that are available at that time (claimed “real-time availability”). Singh teaches on column 5 line 45-47, the listing is obtained from the internet.

Singh failed to teach “a rate of each service provider”. However, Faber et al teach on Fig. 6, a web page showing rate (price per minute) of a service provider.

Singh teaches on column 4 line 17-20 the user selects a specific service provider to initiate the call.

Singh teaches on column 4 line 63-66 the call is initiated from the wireless communicator to the service provider.

Singh teaches on column 5 line 25-50 when the initial call is not successfully connected, either identifying a geographic location to obtain an alternate service provider list, or obtaining from a yellow page directory that includes alternate service provider in the geographic location.

It would have been obvious to one skilled at the time the invention was made to modify Singh to have the “a rate of each service provider” as taught by Faber et al such that the modified system of Singh would be able to support the system users with a detail rate information for selecting the service provider.

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Regarding claims 3, 34, 43, 83, Singh teaches on steps 404, 406, 408, 410, 412 Fig. 4 and column 6 line 66 to column 7 line 9 yellow pages (claimed “alternate service provider”) is provided after the user has completed a communication with the selected service provider.

Regarding claims 6, 26, 46, 60, 86, Singh teaches on column 6 line 67 to column 7 line 1 the user has a conversation with the specific service provider (reads on claimed “a live person”).

Regarding claims 17, 18, all rejections as stated in claim 1 above apply.

Singh teaches on item 105 Fig. 1A communication interface.

Singh teaches on Fig. 1A communicator (the claimed “controller computer”).

Regarding claim 97, all rejections as stated in claim 1 above apply.

Singh teaches on column 6 line 66 to column 7 line 3 reconnecting to the same service provider.

10. Claims 5, 25, 45, 59, 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singh as applied to claim 4 above, and in view of Faber et al and further in view of Salimando (US: 6563915). The modified system of Singh in view of Faber et al as stated in claim 4 above failed to teach “the information.....recorded transmission”. However, Salimando teaches on column 2 line 14-16 the service provider provides a stored (claimed “recorded”) information service to telephone customers. It would have been obvious to one skilled at the time the invention was made to modify Singh in view of Faber et al to have the “the



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information.....recorded transmission” as taught by Salimando such that the modified system of Singh in view of Faber would be able to support the recorded information to the system users.

11. Claims 8, 20-23, 41, 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singh as applied to claim 1 above, and in view of Faber and further in view of Mangetsu (US: 2002/0095359). The modified system of Singh in view of Faber et al as stated in claim 1 above failed to teach “the user’s selection.....internet connection”. However, Mangetsu teach on sections [0061], [0065], and claim 4 page 8 selecting a particular web page (claimed “selection of a service provider”) via the internet from the communication terminal (mobile telephone). It would have been obvious to one skilled at the time the invention was made to modify Singh in view of Faber et al to have the “the user’s selection.....internet connection” as taught by Mangetsu such that the modified system of Singh in view of Faber et al would be able to support the selection over an internet connection to the system users.

12. Claims 9-15, 28-33, 35, 47-55, 67-75, 87-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singh as applied to claim 1 above, and in view of Reece et al (US: 5915214).

Regarding claims 9, 28, 47, 67, 87, the modified system of Singh in view of Faber et al as stated in claim 1 above failed to teach “the pre-established.....service provider”. However, Reece et al teach on column 6 line 39-43 select the lowest-cost service provider. It would have been obvious to one skilled at the time the invention was made to modify Singh in view of Faber et al to have the “the pre-established.....service provider” as taught by Reece et al such that the

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modified system of Singh in view of Faber et al would be able to support the selection based on the rate to the system users.

Regarding claims 10, 29, 48, 68, 88, the modified system of Singh in view of Faber et al and further in view of Reece et al as stated in claim 9 above failed to teach “the pre-established.....provider’s rate”. However, Reece et al teach on column 13 line 5-7 and column 14 line 62-65 select the service provider based on the preset threshold price level (reads on claimed “within a predetermined range”). It would have been obvious to one skilled at the time the invention was made to modify Singh in view of Faber et al and further in view of Reece et al to have the “the pre-established.....provider’s rate” as taught by Reece et al such that the modified system of Singh in view of Faber et al and further in view of Reece et al would be able to support the predetermined range of rate to the system users.

Regarding claims 11, 30, 51, 71, 91, the modified system of Singh in view of Faber et al failed to teach “the pre-established.....subject matter”. However, Reece et al teach on Fig. 7 services (voice mail, e-mail, pages, faxes) are claimed “subject matters” for consideration in selecting the service providers. It would have been obvious to one skilled at the time the invention was made to modify Singh in view of Faber et al to have the “the pre-established.....subject matter” as taught by Reece et al such that the modified system of Singh in view of Faber et al would be able to support the subject matter to the system users.

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Regarding claims 12, 31, 52, 74, 92, the modified system of Singh in view of Faber et al failed to teach “the pre-established.....separate criteria”. However, Reece et al teach on column 12 line 19-21, column 14 line 59 to column 15 line 3 (most of column 12 line 14 to column 15 line 3) in addition to the rate, other considerations (types of service offerings) are also criteria for selecting the optimal service provider. It would have been obvious to one skilled at the time the invention was made to modify Singh in view of Faber et al to have the “the pre-established.....separate criteria” as taught by Reece et al such that the modified system of Singh in view of Faber et al would be able to support the combination of separate criteria to the system users.

Regarding claims 13, 14, 32, 33, 49, 50, 53, 54, 69, 70, 72, 73, 89, 90, 93, 94, the modified system of Singh in view of Faber et al failed to teach “a system administer establishes the set of criteria”. However, Reece et al teach on column 3 line 27-32 utilize the user-defined parameters (criteria) to select the optimal service provider. The “user” is the claimed “administrator” of the mobile communication device. It would have been obvious to one skilled at the time the invention was made to modify Singh in view of Faber et al to have the “a system administer establishes the set of criteria” as taught by Reece et al such that the modified system of Singh in view of Faber et al would be able to support the criteria established by the administrator to the system users.

Regarding claims 15, 35, 55, 75, 95, the modified system of Singh in view of Faber et al failed to teach “the pre-established.....reliability factor”. However, Reece et al teach on column

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12 line 53-55 in addition to other criteria for selecting the optimal service provider, the strongest signal (reads on claimed “reliability factor”) is also a criteria. It would have been obvious to one skilled at the time the invention was made to modify Singh in view of Faber et al to have the “the pre-established.....reliability factor” as taught by Reece et al such that the modified system of Singh in view of Faber et al would be able to support the reliability factor to the system users.

13. Claims 16, 36, 56, 76, 96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singh as applied to claim 15 above, and in view of Faber et al, and further in view of Reece et al, and further in view of Nakano (US: 2002/0193135). The modified system of Singh in view of Faber et al and further in view of Reece et al as stated in claim 15 above failed to teach “the reliability.....previous users”. However, Nakano teaches on section [0037] selects a base station with the highest success call connection rate. “Official Notice” is also taken that it is old and well known to one skilled in the art that a successful connection rate refers to a ratio of the number of successful connections to total number of connection attempts between the service provider and previous users. It would have been obvious to one skilled at the time the invention was made to modify Singh in view of Faber et al and further in view of Reece et al to have the “the reliability.....previous users” as taught by Nakano such that the modified system of Singh in view of Faber et al and further in view of Reece et al would be able to support the successful connection rate to the system users.

14. Claim 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over Singh as applied to claim 57 above, and in view of Faber et al. The modified system of Singh in view of Faber et

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al failed to teach “the selected.....service provider”. However, “Official Notice” is taken that it is old and well known in one skilled in the art that receiving a commission for referral of a customer is a common business practice. It would have been obvious to one skilled at the time the invention was made to modify Singh in view of Faber et al to have the “the selected.....service provider” such that the modified system of Singh would be able to support the commission to the system users.

15. Claims 65, 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singh as applied to claim 57 above, and in view of Faber et al and further in view of Dillon (US: 6067561). The modified system of Singh in view of Faber et al failed to teach “the selected.....with the user”. However, Dillon teaches on column 2 line 14- 31 when the user (reads on claimed “selected service provider”) is prevented in receiving the incoming telephone call (reads on claimed “missed connection”) an email notification is sent. It would have been obvious to one skilled at the time the invention was made to modify Singh in view of Faber et al to have the “the selected.....with the user” such that the modified system of Singh in view of Faber et al would be able to support the email notification of missed connection to the system users.

16. Claim 99 is rejected under 35 U.S.C. 103(a) as being unpatentable over Singh as applied to claim 97 above, and in view of Faber et al and further in view of Khazaka et al (US: 6542732). The modified system of Singh in view of Faber et al failed to teach “the user.....with the user”. However, Khazaka et al teach on column 1 line 27-33 a wireless telephone user may select

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leaving a message with a callback number for reconnection. It would have been obvious to one skilled at the time the invention was made to modify Singh in view of Faber et al to have the “the user.....with the user” such that the modified system of Singh in view of Faber et al would be able to support the method of reconnection to the system users.

17. Claim 100 is rejected under 35 U.S.C. 103(a) as being unpatentable over Singh as applied to claim 97 above, and in view of Faber et al and further in view of Owen et al (US: 6611501). The modified system of Singh in view of Faber et al failed to teach “the user.....service provider”. However, Owen et al teach on column 14 line 37-40 reserve a time for callback. It would have been obvious to one skilled at the time the invention was made to modify Singh in view of Faber et al to have the “the user.....service provider” such that the modified system of Singh would be able to support the time for reconnect to the system users.

### ***Response to Arguments***

18. Applicant's arguments filed on 6/28/04 have been fully considered but they are not persuasive.

- i) Applicant argues, on pages 21-38, regarding rejections relative to the new amendments. Rejections necessitated by the new amendments have been stated above.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703)

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305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

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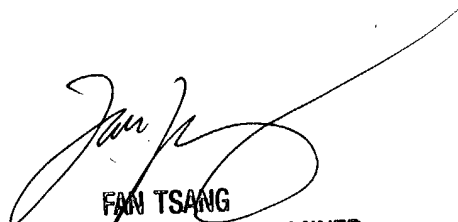
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Patent Examiner

Art Unit 2645

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